UNITED STATES PATENT AND TRADEMARK OFFICE

R2003-111

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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FEB 10 2003

In re

: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 11, 12, 17, and 23 of the morning section and questions 3 and 5 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On July 9, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional 2 points for morning questions 11 and 12. Accordingly, petitioner has been granted an additional 2 points on the Examination. No credit has been awarded for morning questions 17 and 23 and afternoon questions 3 and 5. Petitioner's arguments for these questions are addressed individually below.

Morning question 17 reads as follows:
17. Which one of the following applications is eligible for Patent Term Adjustment under the Patent Term Guarantee Act of 1999?

(A) A plant application filed June 8, 1995.

(B) A utility application filed June 8, 1995.

(C) A design application filed May 29, 2000.

(D) A continued prosecution application (CPA) filed on June 6, 2001 where the CPA is based upon a plant application originally filed on February 2, 2000.

(E) A utility application originally filed on February 2, 2000 when a request for continued examination (RCE) was filed on June 6, 2001.

17. The model answer: (D) is correct. An original plant or utility application filed on or after May 29, 2000 is eligible for patent term adjustment. See 35 U.S.C. § 154(b), 37 C.F.R. § 1.702 and MPEP § 2730 . Since a continued prosecution application (CPA) filed under 37 C.F.R. § 1.53(d) is a new (continuing) application, a CPA filed on or after May 29, 2000 is eligible for patent term adjustment. See MPEP § 2730. Applications filed on or after June 8, 1995 may accrue patent term extension under 35 U.S.C. § 154(b), but patent term extension is much more limited that PTA and should not be confused with PTA. Accordingly, Answers (A) and (B) are wrong. Answer (C) is wrong because design applications are not eligible for patent term adjustment. See 37 C.F.R. § 1.702 and MPEP § 2730. Answer (E) is wrong because a request for continued examination (RCE) under 35 U.S.C. § 132(b) and 37 C.F.R. § 1.114 is not a new application and filing an RCE in an application filed before May 29, 2000 will not cause the application to become eligible for patent term adjustment. See MPEP § 2730.

Petitioner argues that answer (E) is correct. Petitioner contends that answer (D) is an incorrect answer because the CPA is filed after May 29, 2000. Petition further contends that although answer (E) does not make the application eligible for PTA, answer (E) does make the application eligible for Patent Term Extension.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (D) is an incorrect answer because the CPA is filed after May 29, 2000, answer (D) is the most correct answer as it is the only answer that would allow the patent application to be eligible for Patent Term Adjustment. CPAs are allowed for prior nonprovisonal applications filed prior to May 29, 2000. See 37 CFR 1.53(d)(1)(i)(A) and MPEP 201.02(d). In answer (D), the prior nonprovisonal plant application was filed on February 2, 2000, which is prior to May 29, 2000. Therefore, a CPA could have been filed in the originally filed plant application of answer (D). The filing of a CPA, which is accords a new filing date to the application, would make the plant application eligible for PTA. Answer (E), as correctly noted by petitioner,

would not make the application eligible for PTA. Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 23 reads as follows:
23. An international application designating the United States is filed with the USPTO in its capacity as a Receiving Office, which properly accords the application an international filing date of 02 August 2001. The application properly claims priority solely to an earlier British application filed 02 August 2000. A Demand was not filed within 19 months from this priority date. On 10 April 2002, applicant filed a "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. § 371" (Form PTO-1390), which identified the international application, and was accompanied by payment in full of the basic national fee. An oath or declaration, as required under 35 U.S.C. § 371(c)(4), was not submitted. As of 10 April 2002, the U.S. national stage application was:

(A) Abandoned for failure to submit the basic national fee within 20 months from the priority date.

(B) Abandoned for failure to submit the basic national fee and copy of the international application within 20 months from the priority date.

(C) Abandoned for failure to submit the basic national fee, copy of the international application, and oath or declaration within 20 months from the priority date.

(D) Abandoned for failure to submit the basic national fee within 20 months from the international filing date.

(E) Not abandoned.

23. The model answer: The correct answer is (E). PCT Article 22 was recently amended to permit applicant to delay entry into the national stage until 30 months from the earliest claimed priority date, regardless of whether a Demand was filed within 19 months from said date. The change is effective for international applications where the former Article 22 time limit of 20 months expired on or after 01 April 2002.

Petitioner argues that answer (A) is correct. Petitioner argues that PCT Article 22 as reprinted in the 8th edition of the MPEP supports his answer of (A) being the most correct. Petitioner acknowledges that he was aware of recent amendments to PCT Article 22, but decided to rely on the information as reprinted in the 8th edition of the MPEP.

Petitioner's arguments have been fully considered but are not persuasive. The petitioner should note that the instructions to the examination clearly state that:

> The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by** a court decision, a notice in the Official Gazette, or **a notice in the Federal Register**. (emphasis added)

The change to the rules of practice was published in the Federal Register on January 4, 2002 (**67 Fed. Reg. 520**), which is posted on the USPTO website at http://www.uspto.gov/web/offices/com/sol/notices/finrule.pdf. According to the Federal Register notice, the change was effective on April 1, 2002 for all international (PCT) applications in which the twenty-month period from the priority date expired on or after April 1, 2002, and in which the applicant has not yet entered the national stage as defined in 37 CFR 1.491(b) by April 1, 2002. Therefore, the amendment to PCT Article 22 was applicable to the application in the question above because the twenty-month period expired on April 2, 2002 (which is after April 1, 2002) and the applicant had not yet entered the national stage as defined in 37 CFR 1.491(b). Accordingly, model answer (E) is correct because the application is not abandoned under amended PCT Article 22, and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 3 reads as follows:

3. When filing a reissue application in November 2001 for the purpose of expanding the scope of the original patent claims, which of the following would not be in accordance with the USPTO rules of practice and procedure?

(A) The specification, including the claims, of the patent for which reissue is requested, must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper.

(B) Applicant's intent to broaden the scope of the claims can be made known in a reissue application filed within 2 years of the patent grant date by presenting in the application when filed new or amended claims.

(C) Any amendments made to the original patent by physically incorporating the changes within the specification or by way of a preliminary amendment must comply with the revised amendment practice of 37 CFR 1.121(b) and (c) and include appropriate "clean" and "marked-up" versions of the paragraphs or claims being amended.

(D) Applicant's intent to broaden the scope of the claims can be made in a reissue application filed within 2 years of the patent grant date by specifying in the reissue

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In re

: DECISION ON
: PETITION FOR
: REVIEW OF DIRECTOR'S
: DECISION
: UNDER 37 CFR 10.2(c)

MEMORANDUM AND ORDER

(petitioner) petitions for review of the Director's decision mailed on February 10, 2003 under 37 CFR 10.2(c) and requests reconsideration for the answers to question 23 of the morning section and question 5 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On July 9, 2002, petitioner requested regrading, arguing that the model answers were

incorrect. On February 10, 2003, the Office mailed a decision on the petition for regrade denying the petition to the extent that the petitioner seeked a passing grade on the Registration Examination. Petitioner was given credit for questions 11 and 12 of the morning session, and accordingly, petitioner's score was increased to 69. On March 5, 2003, petitioner filed a petition for review of Director's decision under 37 CFR 10.2(c).

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of the Office of Patent Legal Administration.

OPINION

Under 37 CFR 10.2(c), any petition for review of Director's decision shall contain (1) a statement of the facts involved and the points to be reviewed and (2) the action requested. Briefs or memoranda, if any, in support of the petition shall accompany or be embodied therein. The petition will be decided on the basis of the record made before the Director and no new evidence will be considered by the Director in deciding the petition. For a petition for regrade, pursuant to 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded no additional points for morning question 23 and afternoon question 5. Accordingly, petitioner has been granted no additional points as a

result of the review of the Director's decision. No credit has been awarded for morning questions 23 and afternoon question 5. Petitioner's arguments for these questions are addressed individually below.

Morning question 23 reads as follows:
23. An international application designating the United States is filed with the USPTO in its capacity as a Receiving Office, which properly accords the application an international filing date of 02 August 2001. The application properly claims priority solely to an earlier British application filed 02 August 2000. A Demand was not filed within 19 months from this priority date. On 10 April 2002, applicant filed a "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. § 371" (Form PTO-1390), which identified the international application, and was accompanied by payment in full of the basic national fee. An oath or declaration, as required under 35 U.S.C. § 371(c)(4), was not submitted. As of 10 April 2002, the U.S. national stage application was:

(A) Abandoned for failure to submit the basic national fee within 20 months from the priority date.

(B) Abandoned for failure to submit the basic national fee and copy of the international application within 20 months from the priority date.

(C) Abandoned for failure to submit the basic national fee, copy of the international application, and oath or declaration within 20 months from the priority date.

(D) Abandoned for failure to submit the basic national fee within 20 months from the international filing date.

(E) Not abandoned.

23. The model answer: The correct answer is (E). PCT Article 22 was recently amended to permit applicant to delay entry into the national stage until 30 months from the earliest claimed priority date, regardless of whether a Demand was filed within 19 months from said date. The change is effective for international applications where the former Article 22 time limit of 20 months expired on or after 01 April 2002.

Petitioner argues that answer (A) is correct. Petitioner argues that PCT Article 22 as reprinted in the 8th edition of the MPEP supports his answer of (A) being the most correct. Petitioner acknowledges that he was aware of recent amendments to PCT Article 22, but decided to rely on the information as reprinted in the 8th edition of the MPEP. In the petition for review of Director's decision, petitioner further argues that he never received written USPTO notice of the amendment to Article 22 anytime prior to the April 2002 examination, and that reliance on the USPTO website for keeping informed of recent changes is impractical in an examination setting. Therefore, the petitioner contends that reliance of the information in the MPEP (8th edition) was the "most reasonable approach in answering the question."

Petitioner's arguments have been fully considered but are not persuasive. The petitioner should note that the instructions to the examination clearly state that:

> The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, **unless modified by** a court decision, a notice in the Official Gazette, or **a notice in the Federal Register**. (emphasis added)

Therefore, the instructions explicitly state that petitioner has a duty to be aware of any recent changes to the MPEP that are modified by a notice in the Federal Register. The fact that the petitioner was not personally notified by mail of the Federal Register notice is not relevant. The Federal Register is a widely-available printed publication that is available to the public in paper form and also electronically via many government, university and corporate websites. The change to the rules of practice was published in the Federal Register on January 4, 2002 (**67 Fed. Reg. 520**), which is posted on the USPTO website at http://www.uspto.gov/web/offices/com/sol/notices/finrule.pdf. According to the Federal Register notice, the change was effective on April 1, 2002 for all international (PCT) applications in which the twenty-month period from the priority date expired on or after April 1, 2002, and in which the applicant has not yet entered the national stage as defined in 37 CFR 1.491(b) by April 1, 2002. Therefore, the amendment to PCT Article 22 was applicable to the application in the question above because the twenty-month period expired on April 2, 2002 (which is after April 1, 2002) and the applicant had not yet entered the national stage as defined in 37 CFR 1.491(b). Accordingly, model answer (E) is correct because the application is not abandoned under amended PCT Article 22, and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 5 reads as follows:
5. Regarding correction of inventorship in a pending application, where no waiver is granted, which of the following is not required under USPTO practice and procedure?

(A) In connection with filing an amendment to correct inventorship in a nonprovisional application, seeking the deletion of one of the four co-inventors, because, in light of the cancellation of three claims, that inventor's invention is no longer being claimed, the submission of a statement from the person whose name is being deleted that there was no deceptive intent on his part in being named in the original application.

(B) In connection with filing an amendment to correct inventorship in a provisional application, seeking the deletion of one of the four co-inventors, the submission of a statement from the person whose name is being deleted that there was no deceptive intent on his part in being named in the original application.

(C) In connection with filing an amendment to correct inventorship by adding previously omitted inventors to a nonprovisional application that has been assigned, the submission of a written consent from the assignee.

(D) In connection with filing an amendment to correct inventorship by adding previously omitted inventors to a provisional application, the submission of a statement that the inventorship error occurred without deceptive intention on the part of the omitted inventors.

(E) In connection with filing an amendment to correct inventorship in a nonprovisional application involved in an interference, the submission of a motion under 37 CFR 1.634.

5. The model answer: (A) is the most correct answer. *See* 37 C.F.R. § 1.48(b) (where the claims covering that inventor's invention are cancelled, a statement regarding lack of deceptive intent is not required). (B) is incorrect. *See* 37 C.F.R. § 1.48(e)(2). (C) is incorrect. *See* 37 C.F.R. § 1.48(c)((5). (D) is incorrect. *See* 37 C.F.R. § 1.48(d)(1). (E) is incorrect. *See* 37 C.F.R. § 1.48(a), (b) & (c).

Petitioner argues that answer (C) is correct. Petitioner contends that the clause "where no waiver is granted" makes the question ambiguous. Petitioner stated that he interpreted that clause to be "related to the status of the inventor's involvement with the pending application." Petitioner stated he believed that that clause meant that the inventor was contesting being deleted as an inventor from the application. In the petition for review of Director's decision, petitioner further states that the Director's decision "fails to address any possibility that the question is ambiguous," and asserts that the Director has not explained how petitioner's answer (c) is "incorrect." Petitioner lists numerous references to "waivers" found throughout the MPEP to illustrate his point that the question is ambiguous. Furthermore, petitioner contends that his reliance on "waiver of confidentiality under sections 1.53(d)(6) and 1.48 was reasonable," therefore making answer (C) a correct answer.

Petitioner's arguments have been fully considered but are not persuasive. First, contrary to petitioner's statement that the clause "where no waiver is granted" makes the question ambiguous, the clause must be read in context of the question. The fact that the MPEP mentions the term "waiver" in numerous areas unrelated to the correction of inventorship is not relevant to the question. When read in proper context, the phrase was clearly referring to no waiver of policy being granted under 37 CFR 1.183 as this is a waiver that would have a direct impact on the correct answer to the question. In extraordinary situations, when justice requires, any requirements of the regulations that are not also statutory requirements can be waived or suspended under 37 CFR 1.183. For example, the requirement in 37 CFR 1.48(e)(2) for a statement that the inventorship error occurred without deceptive intention may be waived in extraordinary situations, when justice requires. If such a requirement was waived, then answer (B) would be correct. Because the question rules out that possibility by the clause "where no waiver is granted," answer (A) is the most correct answer. Furthermore, contrary to petitioner's

assertion that the Director's decision failed to explain how the petitioner's answer is incorrect, it is the petitioner that has the burden to prove that the model answer is incorrect. See 37 CFR 10.7(c). The Director's decision need only state that the petitioner has failed to make the required showing, and need not "prove" that the petitioner's answer is incorrect.

In addition, the petitioner's argument that his reliance on his interpretation of the clause "where no waiver is granted" refers to the waiver of confidentiality under 37 CFR 1.53(d)(6) and 1.48 is reasonable is not persuasive. The petitioner has failed to make a showing that such reliance is "reasonable." The petitioner states that he "concluded" that the "inventor had not granted waiver of his patent rights in the pending application and therefore assignee written consent is unnecessary." First, the waiver of confidentiality under 37 CFR 1.53(d)(6), for example, pertains to when applicant files a continuation prosecution application (CPA) which is not relevant to the facts presented in the question. The facts do not state that a CPA was filed. Petitioner is reminded that the instructions to the examination state that petitioner should not assume any facts. Second, an inventor does not "waive" his interest in an application to an assignee, but instead "assigns" his interest to the assignee. Accordingly, model answer (A) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

In the decision for the petition for regrade, 2 points were added to petitioner's score on the Examination. Therefore, petitioner's score is 69. No points have been added as a result of the petition for review of the Director's decision. Accordingly, petitioner's score is still 69. This score is insufficient to pass the Examination.

Upon review of the Director's decision and reconsideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy